

REMARKS/ARGUMENTS

Applicants acknowledge, with appreciation, the indication that claims 4-6, 8-10 and 12 contain allowable subject matter. Claims 1-12 are currently pending, with claims 1 and 11 being in independent form. No amendment to the claims have been made. Reconsideration of the application is respectfully requested.

Overview of the Office Action

Claims 1, 7 and 11 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Pub. No. 2002/0067500 ("*Yokomizo*") in view of U.S. Patent No. 6,344,853 ("*Knight*"). Claims 2 and 3 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Yokomizo* in view of *Knight* and further in view of U.S. Patent No. 4,751,507 ("*Hama*").

Applicants have carefully considered the Examiner's rejection, and the comments provided in support thereof. For the following reasons, applicants respectfully assert that all claims now pending in the present application are patentable over the cited art.

Patentability of the Claims under 35 U.S.C. §103(a)

The Examiner (at pgs. 3-4 of the Office Action) has acknowledged the failure of *Yokomizo* to teach "a second image generating section for generating a second image regard to the first image based on the display condition inputted by the user terminal; and, a window information generating section for displaying the first image and the second image simultaneously". The Examiner cites *Knight* in an attempt to cure the shortcomings of *Yokomizo* and, thereby, render independent claims 1 and 11 unpatentable.

More specifically, the Examiner (at pgs. 3-4) asserts that:

It would have been obvious to one of ordinary skill in the art to include in the invention of Yokomizo the composite imaging ability of Knight *since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.* (Emphasis Added)

However, the Examiner's rejection fails to provide a *prima facie* case of obviousness because it is merely conclusory and fails to provide evidentiary support or reasoning as to why one of ordinary skill in the field of the invention would have deemed it obvious to select and combine the various elements from the references in the manner of applicants' claimed invention.

As explained at Section 2143 of the MPEP, "[t]he rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art". *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395 (Citations Omitted). Section 2143 of the MPEP further notes that 'it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.' *KSR*, 550 U.S. at 401". MPEP 2143.01(IV) states that a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

A recent decision by the U.S. Court of Appeals for the Federal Circuit found that a rejection stating that to combine features of prior art references “to attain the advantages of each would have been obvious to a person of ordinary skill in the art, as this would involve nothing more than the predictable use of prior art elements according to their established functions” is merely conclusory and fails to provide a *prima facie* case of obviousness. *In re Vaidyanathan* 96 USPQ2d 1507, 1515 (CAFC 2010). That language is similar to the above-referenced Examiner’s statement. Accordingly, the present rejection is also merely conclusory and fails to provide a *prima facie* case of obviousness.

Moreover, the *2010 KSR Guidelines Update* clearly explains that “one situation when it is important to identify a reason to combine known elements in a known manner to obtain predictable results is when the combination requires a greater expenditure of time, effort, or resources than the prior art teachings. Even though the components are known, the combining step is technically feasible, and the result is predictable, the claimed invention may nevertheless be nonobvious when the combining step involves such additional effort that no one of ordinary skill would have undertaken it without a recognized reason to do so. When a combination invention involves additional complexity as compared with the prior art, the invention may be nonobvious unless an examiner can articulate a reason for including the added features or steps. This is so even when the claimed invention could have been readily implemented” (Emphasis added).

The Examiner has identified no reason that would have prompted the skilled person to combine the elements of *Yokomizo* and *Knight* in the way applicants’ have disclosed and claimed, and the Examiner has failed to provide a reason for the skilled person to do so. Moreover, combining the teachings of *Yokomizo* and *Knight* involves a level of additional effort

and complexity such that the skilled person would not have undertaken to combine the teachings of *Yokomizo* and *Knight* without a recognized reason to do so.

Knight relates to digitally processing and superimposing “a second image on a first image and to display the composite image, whereby a prospective purchaser can preview the product bearing the logo represented by the composite image” (see col. 3, lines 2-7). *Knight*, however, merely explains that the composite images are superimposed one above the other. Applicants’ claimed invention, however, involves a level of additional complexity as compared to *Yokomizo* and *Knight*, such that independent claims 1 and 11 are not obvious, and the Examiner has failed to articulate a reason for including the added features of *Knight* in the system of *Yokomizo*. Moreover, the Examiner has provided no description of a known method that could permit the skilled person to combine applicants’ claimed elements with no change in their respective functions, as expressly required by *KSR*. Independent claims 1 and 11 are therefore patentable over the combination of *Yokomizo* and *Knight* for *at least* these reasons.

In view of the above remarks, the current rejection of independent claims 1 and 11 based on the combination of *Yokomizo* in view of *Knight* fails to provide a *prima facie* case of obviousness and should be withdrawn.

Patentability of Dependent Claims 2 and 3 under 35 U.S.C. §103(a)

The Examiner (at pg. 4 of the Office Action) acknowledges that the combination of *Yokomizo* and *Knight* fails to teach or suggest “a display section for displaying the first image can select either a whole display or a partial display on the display window of the user terminal; wherein the window information generating section for displaying the first image and the second image simultaneously when the whole display is selected by the user terminal, while displaying a

portion of the first image when the partial display is selected by the user terminal” as recited in dependent claim 2 and “the window information generating section comprising a soft-key for changing the display portion of the first image when partial display is selected by the user terminal, updating the window information in response to an input using the soft-key by the user terminal, and changing and displaying the display portion of the first image”, as recited in dependent claim 3, and cites *Hamas* for these features.

Applicants, however, contend that no combination of *Yokomizo*, *Knight* and/or *Hamas* achieves the subject matter of independent claim 1, from which claims 2 and 3 depend. There is simply nothing in *Hamas* to cure the above-discussed deficiencies in *Yokomizo* and *Knight*, e.g., the lack of teachings relating to applicants’ claimed second image generating section as recited in independent claim 1.

Hama discloses “[a] method ... for creating simultaneously viewable coarse and fine resolution displays, respectively presenting an ‘entire image’ with coarse resolution of detail and a selected portion of that image in an enlarged view with fine resolution of detail” (see Abstract and col. 1, lines 13-22). *Hama* fails to teach or suggest what *Yokomizo* and *Knight* lack. The system achieved by the combination of *Yokomizo*, *Knight* and *Hama* thus fails to achieve the expressly-recited subject matter of independent claim 1. There is simply no reason for the skilled person to combine the teachings of *Yokomizo* or *Knight* with the teachings of *Hamas* to achieve applicants claimed system, absent an impermissible hindsight construction.

The combination of *Yokomizo*, *Knight* and/or *Hamas* thus fails to teach or suggest the express recitations of applicants’ independent claim 1. Since *Yokomizo*, *Knight* and *Hamas*, individually or in combination, fail to teach or suggest the features recited in independent claim

1, dependent claims 2 and 3 are deemed to be patentable based *at least* on their dependency from claim 1.

Dependent Claims

In view of the patentability of independent claims 1 and 11, for the reasons presented above, each of dependent claims 2-10 and 12 is respectfully deemed to be patentable therewith over the prior art. Moreover, each of these claims includes features which serve to still further distinguish the claimed invention over the applied art.

Conclusion

Based on all of the above, applicants submit that the present application is now in full and proper condition for allowance. Prompt and favorable action to this effect, and early passage of the application to issue, are once more solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned to facilitate an early resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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